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WENDEROTH, LIND & PONACK L.L.P.			MARANDI, JAMES R	
2033 K. STREET, NW				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/580,693	KATAOKA, MITSUTERU	
	<b>Examiner</b>	<b>Art Unit</b>	
	JAMES R. MARANDI	2421	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 16 September 2008.

2a) This action is **FINAL**.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-15, 17-33, 35-37 and 39 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-15, 17-33, 35-37 and 39 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 26 May 2006 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____ .
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)	5) <input type="checkbox"/> Notice of Informal Patent Application
Paper No(s)/Mail Date _____ .	6) <input type="checkbox"/> Other: _____ .

## **DETAILED ACTION**

### ***Response to Amendment***

1. This action is in response to applicant's amendment filed on 9/16/2008. Claims 1-15, 17-33, 35-37, and 39 are presently pending. Claims 16, 34, and 38 have been canceled.

In view of applicant's amendment, objections to specification and drawings, as presented in the Office Action of 6/16/2008, is hereby withdrawn.

### ***Claim Objections***

2. Applicant's cancellation of claims 16 and 34 leads to new grounds of objection to claims 17 and 18 (which depend on claim 16) and claims 35 and 36 (which depend on claim 34) as presented. In light of applicant's incorporation of cancelled claims 16 and 34 into currently amended claims 1 and 19, and in order to expedite prosecution, examiner treats claims 17 and 18 as dependent on claim 1, and claims 35 and 36 as dependent on claim 34.

### ***Response to Arguments***

3. Applicant's arguments with respect to claims 1-15, 17-33, 35-37, and 39 have been considered but are moot in view of the new ground(s) of rejection.

Although a new ground of rejection has been used to address additional limitations that have been added to claims 1, 17- 19, 35, 36, and 39, a response is considered necessary for several of applicant's arguments since Ellis, DeFreese, Schein, and Wagner references will continue to be used to meet several claimed limitations.

- a. Applicant argues that "***at least the following features of the present invention (as recited in claims 1, 19 and 38) are not believed to be disclosed or suggested by the cited prior art.***  
***1) obtaining a recommendation reason for a program; and***  
***2) including the obtained recommendation reason in a notification screen, wherein***  
***the obtained recommendation reason is in a form which is recognized by a user.***

***In the Office Action, the Examiner relies on Ellis for disclosing or suggesting all the features recited in independent claims 1 and 19.***

*However, the Applicants maintain that Ellis fails to disclose or suggest the features recited in independent claims 1 and 19 (as amended) as well as the features of new independent claim 39.” (Page 17 of Remarks, ¶¶ 3<sup>rd</sup> and 4<sup>th</sup>)*

Examiner disagrees. Features cited by the applicant were previously presented by the applicant as claims 16 and 34 (presently cancelled).

Examiner has already cited that these features were not taught by Ellis. However, Defreese's disclosure (Fig. 20, elements 422, 424, 432 where program theme and show times are illustrated for example; and Col. 27, lines 38- 41; in this example the theme and show times are sorted and presented. However, programs can be sorted and displayed based on any one of program characteristics.) Was combined with Ellis' invention to reject said claim as per 35 USC § 103(a).

- b. Applicant further argues that “*Specifically, Ellis discloses at column 14, lines 20-24 the use of a "hot list" (see also Fig. 25). Specifically, the "hot list" is displayed for one minute prior to the scheduled start time of a program. However, the "hot list" disclosed in Ellis is clearly different from the notification screen of the present invention. In fact, the "hot list" of Ellis more accurately corresponds to the claimed "list screen" (e.g., recited in claim 7) of the present invention.*” (Page 17 of Remarks, last paragraph)

Examiner Disagrees. Applicant is referred to Ellis' Figs. 26 and 27 where Ellis demonstrates that the "HOT list" is actually presented to the user. The timing of such notification is chosen based on user desires (Col. 14, lines 20-24). Furthermore, the content is also based on user desires and is sorted accordingly, as shown in Fig. 27. The "list" is used to remind the viewer as to upcoming programs (within a period of time selected by the user).

- c. Applicant further argues that "***the notification screen of the present invention is overlaid with information regarding a limited number of recommended programs, which makes it possible to reduce the area of the notification screen. This advantage of the present invention is not believed to be disclosed or suggested by Ellis.***" (Page 18 of Remarks, 1<sup>st</sup> paragraph)

Examiner presents that Ellis clearly demonstrates that the "HOT list" is overlaid on the screen (Fig. 25). The extent of this list is fully dependant on the extent of viewers' selections and desires. However, DeFreese further discloses how to change the size and the extent of information presented to the user (Fig. 4, elements 114, 116, 125, and 127)

- d. As to applicant's argument that "***... nowhere in Ellis does it disclose or suggest the use of recommendation reasons on a notification screen, wherein the recommendation reasons are in a form that is recognized by a***

*user. This deficiency in Ellis was also noted by the Examiner in the Office Action (see page 9, lines 1-4). ”* (Page 18 of Remarks, 2<sup>nd</sup> paragraph)

Examiner agrees. However, examiner presented DeFreese's disclosure (Fig. 20, elements 422, 424, 432 where program theme and show times are illustrated for example; and Col. 27, lines 38- 41; in this example the theme and show times are sorted and presented. However, programs can be sorted and displayed based on any one of program characteristics.), in combination with Ellis, as per 35 USC § 103(a).

- e. Applicant further argues that *“DeFreese fails to overcome the deficiencies noted above in Ellis. DeFreese is directed to a system and method for providing full service cable television, which includes digital and analog transmission architecture capable of delivering a high number of high quality television programs, advance cable services, and on line services to a subscriber's home.*

*In the Office Action, the Examiner relies specifically on column 27, line 38-41 of DeFreese for disclosing or suggesting the use of a recommendation reason on a notification screen. However, DeFreese at column 27, lines 38-41 actually discloses that a start time, a theme, and the like are used for sorting a display list. And, the start time, the theme, and the like used for sorting a display list disclosed in DeFreese do not provide the same*

***advantages provided by the use of a "recommendation reason," as recited in claims 1, 19 and 39.*** (Page 18 of Remarks, last two paragraphs, and page 19, 1<sup>st</sup> paragraph)

Examiner Disagrees. First, DeFreese, in the context of 35 USC § 103(a), is in an art area analogous to that of Ellis. Second, Defreese's, discloses more than just timing and theme as desirable parameters selectable by the user (see Col. 27, lines 38-41, emphasis added)

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1- 3, 7, 9- 12, 14, 17, 19- 21, 25, 27- 30 , 32, 35, 37 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over M.D. Ellis, USPN 7,185,355 (hereinafter “Ellis”) in view of D.L. DeFreese et al., USPN 6,493,876 (hereinafter “DeFreese”).

Regarding claims 1, 19, 37, and 39, Ellis discloses a **recommended program notification** method, device, and computer code **notifying a user of a recommended program** (Fig. 25; Col. 13, lines 57-61), **comprising the steps of:**

**inputting a user's instruction including a recommendation control instruction** (Figs. 14, 15; Col. 11, lines 4-23);  
**detecting notification timing with which a notification of a recommended program is performed** (Fig. 15, elements 156, 158), **when the recommendation control instruction is not input** (Col. 11, lines 21-23); and  
**displaying a notification screen indicating the existence of a recommended program when the notification timing is detected** (elements 156, 158; Figs. 25, and 26; Col. 14, lines 20-24).

Ellis discloses displaying "hot list" (favorites) sorted by priority (Fig. 27, element 240; Col. 14, lines 1-2) therefore presenting the recommended list based on **obtaining a recommendation reason for a program.**

Ellis does not disclose **including the obtained recommendation reason in the notification screen,**

**wherein the obtained recommendation reason is in a form which can be recognized by a user.**

However, DeFreese, in analogous art, discloses **including the obtained recommendation reason in the notification screen** (Fig. 20, elements 422, 424, 432 where program theme and show times are illustrated for example), **wherein the obtained recommendation reason is in a form which can be recognized by a user** (Col. 27, lines 38- 41; in this example the theme and show times are sorted and presented. However, programs can be sorted and displayed based on any one of program characteristics)

Therefore, it would have been obvious to one of ordinary skills in art, at the time of invention, to modify the system of Ellis with DeFreese's invention in order to provide an convenient way for the user to be kept informed of various programs of interest to the user at the appropriate time according to user preferences.

Regarding claims 2 and 20, **wherein the notification timing detecting step detects timing with which a recommended program starts, as the notification timing** (Ellis, Col. 11, lines 21-31).

Regarding claims 3 and 21 Ellis does not disclose **wherein the notification timing detecting step detects timing with which selected stations are changed, as the notification timing**. However, DeFreese discloses launching

an information banner upon a change in channel (Fig. 4, elements 100, 106, 114; Col. 15, lines 1-12)

Therefore, it would have been obvious to one of ordinary skill in art, at the time of invention, to modify the system of Ellis with DeFreese's invention in order to provide additional viewing convenience to viewer.

Regarding claims 7 and 25, Ellis discloses **displaying a list screen** (226) **indicating a list of recommended programs when the recommendation control instruction is input while the notification screen is being displayed** (Col. 13, lines 57- 61).

Regarding claims 9 and 27 Ellis does not explicitly disclose **erasing the notification screen when a predetermined time has elapsed while the notification screen is being displayed**. However, DeFreese discloses erasing the notification (banner) 114, upon elapse of a predetermined time (e.g. 2 seconds). (Fig. 4; Col. 15, lines 14-17)

Therefore, it would have been obvious to one of ordinary skill in art, at the time of invention, to modify the system of Ellis with DeFreese's invention in order to provide additional viewing convenience to viewer.

Regarding claims 10 and 28 Ellis does not disclose **erasing the notification screen when an instruction other than the recommendation control instruction is input while the notification screen is being displayed.**

However, DeFreese discloses using various key strokes to erase the notifications (Figure 6, Col. 18, lines 50- 55).

Therefore, it would have been obvious to one of ordinary skill in art, at the time of invention, to modify the system of Ellis with Defreese's invention in order to provide additional viewing convenience to viewer.

Regarding claims 11 and 29, Ellis does not explicitly disclose **changing an information amount of a recommended program included in the notification screen when the recommendation control instruction is input.** However, DeFreese discloses **changing an information amount of a recommended program** (Fig. 4, compare elements 124 and 126; Col. 15, lines 34- 38) **included in the notification screen (124, 126) when the recommendation control instruction is input.**

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of invention, to modify the system of Ellis with DeFreese's invention in order to provide additional viewing convenience to viewer.

Claims 12 and 30 are rejected by the same analysis as claims 11, and 29. Appearance and erasure of various menu/ notifications were further analyzed in claims 10, and 28.

Claims 14 and 32 are rejected by the same analysis as claims 12 and 30.

Regarding claims 17 and 35, **wherein the recommendation reason is any one of frequent viewing of a program, appearance of a specific performer in a program, belonging of a program to a specific genre, and inclusion of a specific character string in a document accompanying a program.** (Rejected as claims 1 and 19; See DeFreese Col. 27, lines 38- 41; though in the example theme and show times are sorted and presented, programs can be sorted and displayed based on any one of program characteristics)

5. Claims 4, 5, 6, 8, 22, 23, 24, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis in view DeFreese, in further view of S. M. Schein, USPN 6,732,369 (hereinafter "Schein").

Regarding claims 4 and 22, the system of Ellis and DeFreese does not disclose **where the notification timing detecting step detects timing with which a channel display starts, as the notification timing**. However, Schein, in analogous art, discloses displaying a menu upon **channel display start** (Figs 17; Col. 23, lines 23-33. In Fig. 17B, by clicking the remote, the banner display of 530 is launched on the screen. Element 530 is illustrated to give the user several options which allows for launching/ selection of other options (Menu elements 0-3). One such option is shown in Fig. 17C where the viewer sees TLC 23 while at the same time watching ABC.

Therefore, it would have been obvious to one of ordinary skill in art, at the time of invention, to modify the system of Ellis and DeFreese with Schein's invention in order to provide for ease of program navigation and selection.

Regarding claims 5, and 23 **erasing the notification screen when the channel display is ended**, rejected as claims 4 and 22 (Fig. 17B, menu item (0)).

Claims 6 and 24 are rejected by the same analysis as claims 4, and 22.

Regarding claims 8, and 26, Ellis does not disclose **displaying a video of a recommended program when the recommendation control instruction is input while the notification screen is being displayed.**

However Schein discloses **displaying a video of a recommended program (Fig. 17C, TLC 23) when the recommendation control instruction is input while the notification screen is being displayed** (Fig. 17C; Col 23, lines 40-42)

Therefore, it would have been obvious to one of ordinary skill in art, at the time of invention, to modify the system of Ellis and DeFreese with Schein's invention in order to provide for ease of program navigation and selection.

6. Claims 13, 15, 18, 31, 33, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis in view of DeFrees, in further view of A. Wagner, USPN 6,335,736 (hereinafter "Wagner").

As for claims 13 and 31, the system of Ellis and DeFreese does not disclose

**wherein the notification screen is an icon which is overlaid and displayed on a program video.**

However, Wagner, in analogous art, discloses a **notification Icon** (Fig. 6, elements 40, 41) **overlaid and displayed on a program video** (30).

Therefore, it would have been obvious to one of ordinary skill in art, at the time of invention, to modify the system of Ellis and DeFreese with Wagner's teaching in order to provide for ease of use of program navigation and selection.

Claims 15 and 33 are rejected by the same analysis as claims 13 and 31.

Claims 18 and 36 are rejected by the same analysis as claims 13, and 31.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

***Contacts***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES R. MARANDI whose telephone number is (571)270-1843. The examiner can normally be reached on 8:00 AM- 5:00 PM M-F, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on (571) 272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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